

### **REMARKS**

Claims 1-20 are pending in the present application. Claims 1-10 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 11-20 were objected due to informalities. Claims 1-3, 6-13 and 16-20 were rejected under 35 U.S.C. §102 as being anticipated by Zuschratter et al. ("Acquisition of multiple image stacks with a confocal laser scanning microscope"). Claims 4, 5, 14 and 15 were rejected under 35 U.S.C. §103 (a) as being unpatentable over Zuschratter et al.

Claims 1, 4, 8, 11-16 and 18-20 have been amended. Claims 7 and 17 have been canceled.

#### **Amendments to the claims**

Independent claims 1 and 11 have been amended to recite "defining a specimen region to be examined on a display using a marking line" and a "designation means" to perform the defining, respectively, as well as to recite "displacing the specimen stage in the X-Y plane to scan ... in such a way that the entire specimen region to be examined is covered with a plurality of scan fields, whereby each of the plurality of scan fields cover at least a respective portion of the specimen region to be examined" and a "means for moving the specimen stage" to perform the displacing, respectively. Support for this amendment may be found, for example, at page 9, second and third paragraphs, and Figs. 13 and 14.

Claim 4 and 14 have been amended for agreement with the amended independent claims.

Claims 11-16 and 18-20 have been amended to replace the recitation to "arrangement" with a recitation to "apparatus," and thereby remove the informality, as suggested by the Examiner.

It is respectfully submitted that no new matter has been added.

#### **Rejection under 35 U.S.C. §112 to claims 1-10**

Claims 1-10 were rejected under 35 U.S.C. §112, second paragraph, as being

indefinite. Claim 1 has been amended to remove the recitation to “the” specimen data and thereby remove the antecedent basis problem pointed out by the Examiner. Claim 8 has been canceled, thereby removing the indefiniteness problem therein pointed out by the Examiner. It is respectfully submitted that the claims are now clear and definite.

Withdrawal of the rejection of claims 1-10 under 35 U.S.C. §112 is respectfully requested.

Rejection under 35 U.S.C. §102 to claims 1-3, 6-13 and 16-20

Claims 1-3, 6-13 and 16-20 were rejected under 35 U.S.C. §102 as being anticipated by Zuschratter et al.

Zuschratter et al. describes a method for image acquisition in which a 3D image is formed by automatic 3D scanning of regular rectangular image arrays between selected xyz coordinates using a movable x-y stage. See Abstract and Fig. 1.

Independent claims 1 and 11 of the present application, as amended, recite “defining a specimen region to be examined on a display using a marking line” and a “designation means” to perform the defining, respectively, and “displacing the specimen stage in the X-Y plane to scan ... in such a way that the entire specimen region to be examined is covered with a plurality of scan fields, whereby each of the plurality of scan fields cover at least a respective portion of the specimen region to be examined” and a “means for moving the specimen stage” to perform the displacing, respectively. It is respectfully submitted that Zuschratter et al. does not teach or suggest these features of claims 1 and 11. In contrast, Zuschratter et al. merely describes moving the x-y stage to a new position using a computer or a joystick. At the new position, a series of adjacent rectangular images may be acquired. See Zuschratter et al., p. 178, last paragraph and Fig. 1. Zuschratter et al. thus does not define a specimen region to be examined using a marking line, but rather simply selects a position at which the x-y stage is to be located to start a scan. Moreover, with the system of Zuschratter et al. only regular rectangular areas may be scanned, resulting in the capture of image data not including specimen information and, consequently, an unnecessarily long total image capture time. Thus with Zuschratter et al. each of the plurality of scan fields do not cover at least a respective portion of the specimen region to be examined, as required by

claims 1 and 11. It is respectfully submitted that it would not have been obvious to provide Zuschratter et al. with the above features of claims 1 and 11 as Zuschratter et al. is directed to acquiring a regular rectangular image array at a selected position of the x-y stage, and does not contemplate defining a specimen region to be examined and then limiting the scanning so that each scan field covers at least a portion of the specimen region to be examined, as recited in claims 1 and 11, as amended.

Withdrawal of the rejection of independent claims 1 and 11, as well as their respective dependent claims 2-3, 6-10, 12-13 and 16-20, under 35 U.S.C. §102 based on Zuschratter et al., is respectfully requested.

Rejection under 35 U.S.C. §103 (a) to claims 4, 5, 14 and 15

Claims 4, 5, 14 and 15 were rejected under 35 U.S.C. §103 (a) as being unpatentable over Zuschratter et al.

Claims 4, 5, 14 and 15 properly depend from, and therefore include all of the limitations of respective independent claims 1 and 11. Because, as discussed above, claims 1 and 11 are patentable over Zuschratter et al., it is respectfully submitted that claims 4, 5, 14 and 15 are likewise patentable over Zuschratter et al.

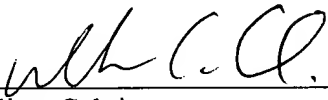
Withdrawal of the rejection of claims 4, 5, 14 and 15 under 35 U.S.C. §103 (a) based on Zuschratter et al. is respectfully requested.

CONCLUSION

It is respectfully submitted that the application is now in condition for allowance.

Respectfully submitted,

DAVIDSON, DAVIDSON & KAPPEL, LLC

By:   
William Gehris  
Reg. No. 38,156

Davidson, Davidson & Kappel, LLC  
485 Seventh Avenue, 14th Floor  
New York, New York 10018  
(212) 736-1940